

REMARKS

Claims 1-18 of the subject application have all been rejected on some basis involving as a primary reference PCT application PCT/US01/18720, WO 01/95745, applicant Cordis Corporation (hereafter "the Cordis reference") having an alleged effective date of June 12, 2000 based upon a priority claim to a U.S. provisional patent application (60/211,157). Applicant herein wishes expressly to reserve any judgment that the Cordis reference is actually entitled to the June 12, 2000 claim of priority based upon the provisional application, because that provisional application has not been compared to the published Cordis reference. Nevertheless, presuming the claim of priority as represented by the examiner to be correct, submitted herewith and incorporated by reference herein is a Declaration under 37 C.F.R. § 1.131 of Mark G. Fleischhacker, the inventor of the subject matter of this application. As is indicated in Mr. Fleischhacker's Declaration he is also Chief Operating Officer of the applicant owner of this application, Lake Region Manufacturing, Inc., and devotes but a small portion of his time to product development related to his own inventions (Paragraph 1).

Mr. Fleischhacker's Declaration and attachments clearly establish that Mr. Fleischhacker conceived and reduced to practice the subject matter of this application long before the alleged effective date of the Cordis reference. The declaration and attachments establish a clear contemplation of the invention from essentially years before the alleged effective date of the Cordis reference. Moreover, the Cordis reference, requiring a structural element "at least two markers positioned near the distal

end of the guidewire....” claims something different than which applicant has invented herein. Thus, it would appear that 37 C.F.R. §1.137 (“Rule 131”) is applicable.

Rule 131 provides that when its conditions are met the applicant will have “sworn behind” the reference, removing it as the basis upon which claims may be rejected. *Cf.*, Horwitz, Patent Office Rules and Practice, 11-9 (2002) (“If the 131 affidavit demonstrates that the applicant’s date of invention is earlier than the effective date of the reference, the reference is eliminated as support for the rejection.”) It follows from the above that the Cordis reference having been removed, rejection of claims 1-18, based thereof should be withdrawn.

It should be noted that applicant’s decision to submit a Rule 131 affidavit should not be construed to mean that the Cordis reference cannot be substantively distinguished from the instant claims. It should be further noted that submission of a Rule 131 declaration should not be construed as having conceded that the provisional application filed June 12, 2000 does, in fact, provide a legitimate claim of priority to the subsequently filed and published PCT application. Applicant specifically reserves the right to contest either or both of those issues in future prosecution.

Claims 19 and 21 stand rejected over the Solar *et al.* reference (U.S. Patent Application Publication US 2002/0084012) having an effective date of December 28, 2000. The Solar *et al.* reference describes and claims “A Method of Manufacturing a Guidewire with an Extrusion Jacket.” Clearly, the Solar *et al.* reference is a different invention from that which is claimed herein in claims 19 and 21. Further, to the extent there is any overlap, the Fleischhacker Declaration, discussed above with respect to the

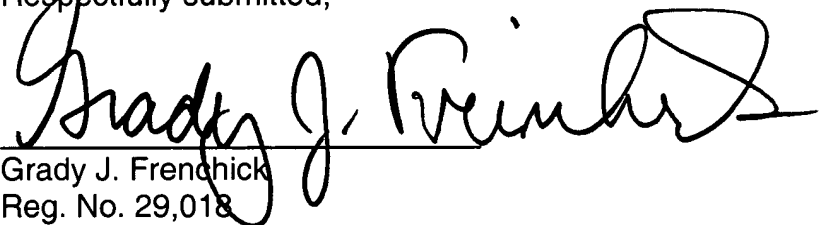
Cordis reference, is equally applicable to the Solar *et al.* reference. Under the analysis posited above, the Fleischhacker Declaration completely removes the Solar *et al.* reference as a basis upon which to reject any of the presently pending claims.

Applicant specifically reserves the right to provide any further analyses or use any other procedural option it believes applicable to distinguish Solar *et al.*, should the need arise.

It is believed that the above references have now been overcome. Should the examiner deem it necessary, a phone call to the undersigned to resolve any outstanding issues would be greatly appreciated.

Respectfully submitted,

Date: 9/8/03


Grady J. Frenchick
Reg. No. 29,018

058442-9191

Michael Best & Friedrich LLP
P.O. Box 1806
Madison, WI 53701-1806
Ph: (608) 283-0109 direct
Fax: (608) 283-2275

Q:\client\058442\9191\B0246143.1